

### REMARKS

In response to the Office Action dated March 15, 2004, Applicant respectfully requests reconsideration based on the above claim amendment and the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance.

In the Office Action dated March 15, 2004, claims 1-32 were rejected as follows:

- Claims 1, 4, 5, and 8 were rejected under 35 U.S.C. § 102(a) as being anticipated by Downes et al. (U.S. Pub. No. 2002/0037074, hereinafter Downes);
- Claims 19 and 22-25 were rejected under 35 U.S.C. § 102(e) as being anticipated by DeSimone (U.S. Patent No. 6,175,619, hereinafter DeSimone);
- Claims 2, 3, 6, 7, 10, 11, and 13-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dowens in view of Harvey et al. (U.S. Patent No. 2002/0059379, hereinafter Harvey);
- Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Dowens and in view of Bouvier et al. (U.S. Patent No. 6,430,276, hereinafter Bouvier);
- Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Dowens and in view of Harvey and further in view of Bouvier;
- Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over DeSimone in view of Downes;
- Claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over DeSimone in view of Sonesh et al (U.S. Patent No. 6,614,783, hereinafter Sonesh);
- Claims 26, 27, 31, and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dowens and in view of Trovato et al. (U.S. Patent No. 6,425,012, hereinafter Trovato);
- Claims 28 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dowens and in view of Morris (U.S. Patent No. 6,339,784, hereinafter Morris); and

- Claim 30 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Downes and in view of DeSimone.

To the extent any of these rejections might still be applied to claims presently pending in this application, it is respectfully traversed.

Claims 1-32 are pending, of which claims 1, 11, 19, and 26 are independent claims. Applicant has amended claims 1, 11, 19, and 26. The support of the amendment can be found at page 10, line 21 to page 11, line 6 of the present application. To the extent the rejections are still applied to the pending claims, they are respectfully traversed.

The present invention, as recited in the preamble of each of claims 1, 11, 19, and 26, relates to a voice chat room service over one or more telephone networks. Claim 1, as amended, recites steps of providing a caller with a menu comprising two or more public voice chat rooms that are predetermined by the service, and routing the caller to a chat room selected by the caller if the caller is a subscriber. Claims 11 and 26 are amended to include similar features. Claim 19, as amended, recites that the user ID numbers comprises a temporary ID number that is given by the service when one or more of the at least two chatters is not a subscriber of the service.

**Rejection under 35 U.S.C. §§102(a) and 102(e)**

Applicant respectfully submits that independent claims 1 and 19 are not anticipated by Downes and DeSimone, respectively.

Downes describes a telecommunication relay device that relays communication from a first party to at least one second party. The purpose of the telecommunication relay device of Downes is to enable two parties that use different types of communication devices, for example, text pager and telephone, to communicate with each other. One illustrated embodiment is

described in col. 5, lines 32 to 49. In this embodiment, the first party calls telecommunication relay device 116 via terminal 128 and the second party is communicating using a voice terminal such as a telephone station (terminal 108). To ensure the two parties communicate properly, controller 202 converts voice signals received from terminal 108 into text and outputs the text into a private room, while new text entered by the first party in the private chat room is converted to voice and transmitted to terminal 108.

It is clear, therefore, Downes does not provide a voice chat room service that allows one or more subscribers to be routed to a voice chat room selected by the caller, as recited in amended claim 1. Downes also does not provide a voice chat room service that provides the caller with a menu comprising two or more public chat rooms that are predetermined by the service, as recited in amended claim 1. In Dowens, the menu is a list of messages received from other callers and thus are not one or more chat rooms predetermined by the service. Furthermore, the private chat room is not a voice chat room, in which both of the first and second parties can chat through voice channels. Indeed, in Downes, the called party can only choose to communicate with a second party from a list of messages received from the controller, but not a voice chat room. After making the choice, telecommunication relay device 116 then opens a private chat room in which the caller can enter text and the telecommunication relay device can transfer the entered text to the calling party as voice signals, and the voice signals of the calling party may be converted to text and entered into the private chat room.

Accordingly, Dowens fails to teach or suggest at least one element of the method recited in amended claim 1. Applicant, therefore, respectfully submits that claim 1 is not anticipated by

Downes and should be patentable. At least due to their dependencies, Applicant further respectfully submits that dependent claims 2- 8 are patentable.

DeSimone describes a system and method for providing anonymous voice communications using a telephone network under the direction of an on-line network. A call broker receives call setup information from on-line session participants, such as a chat room participants, after providing call-back telephone numbers. As described in col. 2, lines 57 to col. 3, line 3, a first caller uses instant message or similar selection button on a screen image to pass a telephone number URL and his/her participant code to a selected chat participant in a current chat room. The selected chat participant then uses the received telephone number URL to go to the telephone company site, and enters the received participant code and a call-back number. Afterward, the company site completes voice links to the first caller and the selected participant.

Clearly, in DeSimone, when the first caller chooses a second caller he would like to communicate, he/she passes his/her code information to the second caller so that the second caller uses the code information of the first caller to complete the link between them. The code information number for the second caller is not given by the call broker, but by the first caller.

DeSimone fails to teach or suggest that the user ID numbers includes a temporary ID number that is given by the service when one or more of the at least two chatters is not a subscriber of the service, as recited in amended independent claim 19.

Accordingly, Applicant respectfully submits that amended independent claim 19 is not anticipated by DeSimone and should be patentable over DeSimone. Further, at least due to their dependencies from a patentable independent claim, claims 20-25 are also considered patentable.

**Rejection under 35 U.S.C. §103(a)**

Independent claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over Dowens in view Harvey.

As admitted by the Examiner, Dowens fails to teach “inviting the caller to be a subscriber if the caller is not a subscriber”. In addition to the discussion provided above regarding claim 1, Applicant further respectfully submits that Downes also fails to teach or suggest supplying the caller with a menu comprising two or more chat rooms; and routing the caller to a chat room selected by the caller, as recited in amended claim 11. The menu provided by Downes is a list of messages received from other callers. It is not a menu comprising two or more chat rooms that are predetermined by the service. Furthermore, Downes fails to teach or suggest routing the caller to a chat room selected by the caller.

Accordingly, even if Harvey does disclose the invitation of a caller to be a subscriber if the caller is not a subscriber, it would not be obvious for one skilled in the art to modify Downes with Harvey to achieve the method of amended claim 11 since the downes/Harvey combination does not include each and every element of amended claim 11.

Therefore, Applicant respectfully submits that claim 11 should be patentable over Dowens and Harvey.

In addition, at least due to their dependencies from patentable independent claims, Applicant also respectfully submits that claims 12-18 are patentable.

Amended Independent claim 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Dowens in view of Trovato.

Based on the same reasons disclosed above, Downes fails to teach or suggest means for providing the caller with a menu comprising two or more public voice chat rooms that are predetermined by the service, and means for routing the caller to one of the plurality of chat rooms selected by the caller. Therefore, even if Trovato describes a plurality of chat rooms, it would not have been obvious for one skilled in the art to modify Downes with Trovato to achieve the system as recited in amended claim 26 since the Downes/Trovato combination does not disclose each and every element of amended claim 26.

Dependent claims 27-32 are also believed to be allowable due to their dependencies from allowable independent claim 26.

Should the Examiner have any questions or determine that any further action is desirable to place this application in even better condition for issue, the Examiner is encouraged to telephone Applicant's undersigned representative at the number listed below.

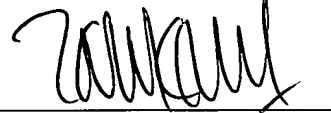
SHAW PITTMAN LLP  
1650 Tysons Boulevard  
McLean, VA 22102  
Tel: 703-770-7696

Date: June 14, 2004

Respectfully submitted,

DANNIE E. MARTIN

By:



Poh C. Chua  
Registration No. 44,615

PCC/CYM/dkp

Customer No. 28970